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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,346	10/31/2003	Kari Systs	915-005,079	9664

4955 7590 08/08/2008
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EXAMINER

WORJLOH, JALATIE

ART UNIT

PAPER NUMBER

3685

MAIL DATE

DELIVERY MODE

08/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/698,346

Applicant(s)

SYSTA ET AL

Examiner

Jalatee Worjloh

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-27-08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11, 13-19, 21-29, 31-41, 43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11, 13-19, 21-29, 31-41, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5-27-08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27, 2008 has been entered.
2. Claims 1, 3-11, 13-19, 21-29, 31-41, 43 and 44 are pending.

Response to Arguments

3. Applicants' arguments filed May 27, 2008 have been fully considered but they are not persuasive.
4. Applicants argued that "no verification is made in Downs to determine the integrity of the information of the package" [i.e. verifying the integrity of the information indicative of the conditions in which distribution of the package is allowed].

However, the Examiner respectfully disagrees. The Clearinghouse in Downs verifies the usage condition that is stored in a secured container(see step 133-143 of col. 18 & 19; col. 27, lines 10-21; col. 59 & 60 – "Usage Conditons Tool").

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3-11-13, 41 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-11, 13-19, 21-29, 31-41, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6226618 to Downs et al. (“Downs”).

Referring to claim 1, Downs discloses verifying the integrity of the information indicative of the conditions in which distribution of the package is allowed, and if the verification of the integrity of the package fails, prohibiting the distribution of the package, if said verifying does not fail, examining said information indicative of the conditions in which the distribution of the package is allowed to determine whether the distribution of the package is allowed and if said examining determines that distribution of the package is allowed, distributing said package (see col. 19 table, steps 133-148 and col. 27, lines 10-21; col. 59 & 60 – “Usage Conditions Tool”).

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Referring to claim 3, Downs discloses the method wherein said package is distributed to another electronic device (see col. 18 table , step 136 & col. 19 table, steps 143-148 - the content store distributes the package to the end-user).

Referring to claim 4, Downs discloses the method wherein said information indicative of the conditions in which the distribution of the package is allowed and the at least one media object are stored in the same file (see col. 18 & col. 19 table).

Referring to claim 5, Downs discloses the method wherein said information indicative of the conditions in which the distribution of the package is allowed and the at least one media object are stored in different files (see col. 18 & col. 19 table).

Referring to claim 6, Downs discloses the method wherein said information indicative of the conditions in which the distribution of the package is allowed is protected by a digital signature (see col. 7, lines 18 -22 – Downs utilizes SC for distribution of packages; the SC is a carrier of information that uses digital signature for protection).

Referring to claim 7, Downs discloses the method wherein a software is executed in the electronic device for controlling the handling of the package, and the modification of the package is prevented by said software (see col. 18 & 19 tables).

Referring to claim 8, Downs discloses the method comprising storing at least one package into a memory of the electronic device, selecting a package from the memory for distribution to a second electronic device, verifying the integrity of the package, examining said information indicative of conditions in which the distribution of the package is allowed or is not

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

allowed to determine if the package can be transmitted or not, and on the basis of said examining either transmitting the selected package to the second electronic device, if it is determined that the transmission is allowed, or not transmitting the selected package to the other electronic device, if it is determined that the transmission is not allowed (see claim 1 above).

Referring to claim 9, Downs discloses the method wherein said information indicative of conditions in which the distribution of the package is allowed or is not allowed comprising at least one detail of the other electronic device, wherein the electronic device communicating with the other device exchanges information on said at least one detail of the other device for determining whether the distribution is allowed or not (see claim 1 above & col. 24, lines 36-40 - the license SC carries the id of the end-user device).

Referring to claim 10, Downs discloses the method wherein said information indicative of conditions in which the distribution of the package is allowed or is not allowed comprising information about the cost of the package and the payment method (see claim 1 above & col. 24, lines 36-40- the license SC carries transaction information, which includes cost of the package and the payment method).

Claims 11 and 14-18 teach a system that performs the steps of method claims 1, 3-11, 13-19 are rejected on the same rationale as claims 1, 3-5, 8-10 above.

Claim 19 teaches an electronic device that performs the steps of method claim 1 above; therefore, this claim is rejected on the same rationale as claim 1 above.

Claims 22 and 23 teach an electronic device that performs the steps of method claims 4 and 5 above; therefore, these claims are rejected on the same rationale as claims 22 and 23 above.

Referring to claim 24, Downs teaches the device wherein the controller is configured for preventing modifying the package (see col. 18 and 19 table – the content is encrypted thereby preventing modifications).

Claims 27 and 28 teach an electronic device that performs the steps of claims 9 and 10 above; therefore, these claims are rejected on the same rationale as claims 9 and 10 above.

Claim 29 is teaches a mobile device that performs the steps of claim 1 above; therefore, this claim is rejected on the same rationale as claim 1.

Claim 31 is a computer readable medium stored with machine executable instructions for performing steps of claim 1 above; therefore, this claim is rejected on the same rationale as claim 1.

Claim 32 is a computer readable medium according to claim 31 that include instructions for performing the steps 8 above; therefore, this claim is rejected on the same rationale as claim 8.

Claim 33 is rejected on the same rationale as claim 1 above.

Claim 35 is rejected on the same rationale as claim 4 above.

Claim 36 is rejected on the same rationale as claim 5 above.

As per claim 40, Downs discloses the information indicative of conditions in which the distribution of the package is allowed comprises at least one of the following: date, time of day, identity of the electronic device, identity of the other electronic device, manufacturer of the electronic device, model or version of the electronic device, model or version of the other electronic device, manufacturer of the package, user subscription information and at least one other detail of the other electronic device (see col. 18 & 19 table - the license SC).

Claim 41 is rejected on the same rationale as claim 1 above.

Claim 42 and rejected on the same rationale as claim 8 above.

Claim 43 is rejected on the same rationale as claim 10 above.

Claim 44 is rejected on the same rationale as claim 1 above.

Conclusion

9. Although the conditional/optional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”

10. Functional recitation(s) using the word “for” or other functional language have been considered but are given little patentable weight³ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

³ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685

although all limitations must be considered, not all limitations are entitled to patentable weight).